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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/062,102	01/31/2002	Cary Lee Bates	END920010052US1	9951
23550	7590	09/19/2005	EXAMINER	
HOFFMAN WARNICK & D'ALESSANDRO, LLC			CANADAY, VELMA D	
75 STATE STREET			ART UNIT	
14TH FL			PAPER NUMBER	
ALBANY, NY 12207			2173	

DATE MAILED: 09/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/062,102

Applicant(s)

BATES ET AL.

Examiner

Velma D. Canaday

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/31/02.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1/31/02</u> . | 6) <input type="checkbox"/> Other: _____ |

Information Disclosure Statement

1. The examiner has considered the information disclosure statement filed on January 31, 2002; please see the attached 1449 form.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1, 4, and 6-8, are rejected because they are directed to non-statutory subject matter. The method claims are not described as being implemented in any tangible and/or limited to any tangible embodiments (e.g. hardware components) in view of Applicant's disclosure. As such the claimed invention is not limited to statutory subject matter and is therefore non-statutory.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 5, and 10-12, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims state a step of selecting a second portion of the selected set of data, wherein the first portion remains selected during the selection of the second portion based upon a predetermined keystroke; and manipulating the selected portions. Both

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claims 5 and 10 are dependent claims that inherit two selected sets of data, therefore it is unclear as to which of the selected sets of data one is to select a second portion from.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Carroll (Pat. No. 6,683,631)

- a. Regarding claims 1, Carroll anticipates the claimed invention by disclosing a method to select a first set of data within the application and selecting a second set of data within the application, wherein the first set of data remains selected during the selection of the second set of data (See Fig. 6 elements 104 and 106).
- b. Regarding claim 2, Carroll teaches performing a predetermined keystroke after the first selecting step, wherein the keystroke allows the first data set to remain selected during the selection of the second set of data (Col 3, lines 35-37; Col 4 lines 3-7).
- c. Regarding claim 3, Carroll teaches a selected region that may be processed by functions such as copy to a buffer, print or cut (Col 1, lines 29-30).

The targeted region that has been selected, the user can then process the information as required. For example, the user could cut the selected information and paste it to a new location (Col 5, lines 41-43).

d. Regarding claim 4, Carroll teaches a system and method that permits a user to make a first selection, perform a process, and then make further modifications to the first selection (Col 2 lines 23-26).

e. Regarding claim 5, Carroll teaches steps that can be repeated until all of the target information is selected and nothing but target information is selected (Col 5, lines 8-10). The teachings allow the user to select portions within data that have been pre-selected. The second portion of selected data can be selected because of the repeated actions of selection.

f. Regarding claims 6 and 13, Carroll teaches target information regions that are noncontiguous without having to select and process each of the noncontiguous target information regions separately (Col 2, lines 6-8).

g. Regarding claims 7,14, and 20, Carroll teaches a preferred embodiment of a electronic document that is text-based, where the user has selected a region of text (Col 3, lines 15-17).

h. Regarding claim 8 and 16, Carroll teaches selecting text when a positional indicator is manipulated in one direction and deselecting text when a positional indicator is manipulated in a second direction (Col 2, lines 11-13).

i. Regarding claim 9, Carroll teaches Windows 95, 98, or NT applications and electronic documents (Col 2, line 66; Col 3, line 15) that allow for

manipulating data. Carroll teaches as discussed above selecting a first set of data, performing a predetermined keystroke, and selecting a second set of data, wherein the first set of data remains selected during the selection of the second set of data.

j. Regarding claim 10, Carroll teaches steps that can be repeated until all of the target information is selected and nothing but target information is selected (Col 5, lines 8-10). The teachings allow the user to select a first and second portion within data that have been pre-selected. By striking a predetermined set of keystrokes on keys, the user preferably creates a begin active select delimiter (Col 4, lines 5-7).

k. Regarding claim 11, Carroll teaches target information that has been selected the user can process for example, the user could print, copy, or delete the selected text (Col 5, lines 20-22). Copying data precedes pasting data, which are sequential functions.

l. Regarding claim 12, Carroll teaches a deselected region having a predetermined boundary, or otherwise distinguished from selected region. Once the target region has been selected, the user and then process the information as required. For example, the user could cut the selected information and paste it to a new location (Col 5, lines 38-43). Manipulation includes for example, print, copy, or deleting the selected text (Col 5, lines 21-22).

m. Regarding claim 15, Carroll teaches an application for writing computer code in the form Hyper Text Markup Language (HTML) (Col 4, lines 40-41).

n. Regarding claim 17, Carroll discloses Windows 95, 98, or NT applications and electronic documents (Col 2, line 66; Col 3, line 15) that allows the user to write computer code in the form Hyper Text Markup Language (HTML) (Col 4, lines 40-41). Carroll additionally discloses selecting a first and second set of data, performing a predetermined keystroke in between the selection while the first set of data remains selected (See Fig. 6, elements 104 and 106; Col 3, lines 35-37; Col 4 lines 3-7). Carroll teaches selecting a portion of one of the selected sets of data as discussed above in claim 5 rejection. Carroll suggests pasting the selected sets of data to a predetermined area, which one must paste once they have cut or copied data, and manipulating the selected portion after pasting. Manipulation includes for example, print, copy, or delete the selected text (Col 5, lines 21-22).

o. Regarding claim 18, Carroll proposes a step of copying the selected sets of data, prior to the pasting step. The selected region may be then processed by functions such as copy to a buffer, print or cut (Col 1, lines 29-30). One of ordinary skill in the art knows that one must copy selected data prior to it being pasted to a predetermined area.

p. Regarding claim 19, Carroll proposes a step of cutting the selected sets of data, prior to the pasting step. The selected region may be then processed by functions such as copy to a buffer, print or cut (Col 1, lines 29-30). One must cut selected data prior to it being pasted to a predetermined area.

q. Regarding claim 21, Carroll teaches preparation and storage of computer software in a machine-readable format such as a floppy or other magnetic, optical or other drive, which upon execution carries out the selective highlight actions of the invention (Col 4, lines 48-52). The software lends itself to the executing the selection of first and second sets of data, while the first set of data remains selected based upon a predetermined keystroke, and selecting a portion of one of the selected sets of data.

r. Regarding claim 22, Carroll teaches sets of directions could be adjusted, either by adjustments to the programming code (Col 5, lines 55-57). The programming code can be adjusted to cut, copy, paste, de-select a set or sets of data, and manipulate the selected portion.

s. Regarding claim 23, Carroll teaches a workstation including a display screen, a CPU, storage and memory, connected by an electronic bus and related circuitry, as well as a keyboard for input (Col 2, lines 57,60-63; Col 3, line 4). The electronic text-based document (Col 3 lines 15-16) that allow the user to select first and second set of data within the application, wherein the first set of data remains selected during the selection of the second set of data based upon a predetermined keystroke, and a portion selection system as discussed above.

t. Regarding claim 24, Carroll discloses pasting the selected sets of data to a predetermined area and manipulating the selected portion after pasting. Manipulation system includes for example, print, copy, or delete the selected text (Col 5, lines 21-22).

- u. Regarding claim 25, Carroll discloses the system of copying, cutting, pasting, (Col 1 lines 29-30) and de-selecting a selected set of data (Col 2, lines 11-12).
- v. Regarding claim 26, Carroll discloses an undo system for de-selecting selected set of data (Col 2, lines 11-12, 16-20).

Conclusion

5. The prior art made of record on form PTO-892 is relied upon and considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to consider these references fully when responding to this action. The documents cited therein teach multiple text selection and manipulations.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Velma D. Canaday whose telephone number is 571-272-2674. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeza can be reached on 571-272-4048. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VC 9/13/05



RAYMOND J. BAYERL
PRIMARY EXAMINER
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